

## REMARKS

### I. Status of Claims

Claims 1-10 are pending in the application, with claims 1-4 being withdrawn pursuant to a restriction requirement. In point of fact, only claims 1-8 are pending since the original claims lacked claims 7 and 8. Thus, claims 9 and 10 have been renumbered as claims 7 and 8, and new claims 9-11 added. From here on, number of claims will reflect this renumbered sequence.

Claim 5 is amended to recite that an *Escherichia coli* culture is prepared, support for which may be found at paragraphs 0098-0105. Claim 5 is also amended to recite that the increased efficiency is with respect to *E. coli* K12 MG1655, support for which may be found at paragraphs 0098-0099, 0101 and 0104-0105. Claim 5 is also amended to recite that the *E. coli* is cultured to an optical density at 650 nm of at least 0.4, support for which may be found at paragraphs 0098-0099, 0101 and 0104-0105. Finally, claim 5 is also amended to recite that the *E. coli* strain is an MDS strain lacking bases 263080-324632, 1398351-1480278, 2556711-2563500, 2754180-2789270, 2064327-2078613, 3451565-3467490, 2464565-2474198, 1625542-1650865, 4494243-4547279, 3108697-3134392, 1196360-1222299, 564278-585331, 15388-20563, 263080-324632, 564278-585331, 602639-608573, 1398351-1480278, 2064327-2078613, 2507650-2515969, 2556711-2563500, 2754180-2789270, 379293-387870, 389121-399029, 2992959-2996892, 3182796-3189712, 3451565-3467490, 2464565-2474198, 1625542-1650785, 4494243-4547279, 3108697-3134392, 1196360-1222299, 687074-688268, 1386912-1396646, 2099418-2135739, 2284410-2288200, 3359747-3365277, 3648921-3651343, 1128637-1140209, 1960605-1977294, 1995085-2021700, 4553059-4594581, 522062-529348, 728616-738185, 1525914-1531648, 3616623-3623309, 3759620-3767868, 1041253-1049768,

1085329-1096603, 2163172-2175230, 3578769-3582674, and 3718262-3719704 of the *E. coli* strain K12 MG1655, support for which may be found at paragraphs 0080-0082 and Tables 1-2.

New claim 9 recites that the bacteria is transformed with a foreign DNA molecule, support for which may be found at paragraphs 0098-0099, 0101 and 0104-0105. New claims 10 and 11, which recite particular optical densities, find support at paragraphs 0015 and 0055, respectively.

Claim 8 is rejected under the first paragraph of 35 U.S.C. §112, claims 5-8 are rejected under the second paragraph of 35 U.S.C. §112, and claims 5-7 stand rejected under 35 U.S.C. §102 over Mersereau *et al.* The specific grounds for rejection, and applicants' response thereto, are set out in detail below.

## **II. Rejections Under 35 U.S.C. §112, First Paragraph**

Claim 8 (original claim 10) is rejected as lacking both written description and an enabling disclosure. It is the examiner's argument that the specification only describes and enables the use of a single strain - MDS41-R13 - for achieving a transformation efficiency of  $10^{10}$  per microgram of foreign DNA. Applicants traverse, but in the interest of advancing the prosecution, claim 5 has been amended to recite that the *E. coli* is an MDS strain lacking bases deleted in MDS41-R13. The rejection is believed overcome, and thus its reconsideration and withdrawal is respectfully requested.

## **III. Rejections Under 35 U.S.C. §112, Second Paragraph**

Claims 5-8 (original claims 5, 6, 9 and 10) stand rejected under the second paragraph of §112. First, the claims are said to be indefinite in not reciting a wavelength for an optical density

of 1.0. Claim 5 has been amended to recite an OD at 650 nm. Second, it is argued that the "increased efficiency" is indefinite without a reference strain. Such a reference strain has been added to claim 5, namely, *E. coli* K12 MG1655. Reconsideration and withdrawal of the rejections is respectfully requested.

#### IV. Rejection Under 35 U.S.C. §102

Claims 5-7 (original claims 5, 6 and 9) stand rejected as anticipated by Mersereau *et al.* Applicants traverse, but in the interest of advancing the prosecution, claim 5 has been amended to recite that the bacteria is *E. coli*. Mersereau *et al.* discusses *Agrobacterium tumefaciens*, not *E. coli*. The rejection is believed overcome, and its reconsideration and withdrawal is thus respectfully requested.

#### V. Conclusion

In light of the foregoing, applicants respectfully submit that all claims are in condition for allowance and an early notification to that effect is earnestly solicited. The examiner is invited to contact the undersigned attorney at (512) 536-3184 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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